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Applicants:	Palacio et al.	Docket No.:	16,422
Serial No.:	09/992,110	T.C./A.U.:	1771
Confirmation No:	7471	Examiner:	Cole, Elizabeth M
Filed:	November 5, 2001	Date:	January 24, 2005
For:	Method of Recycling Bonded Fibrous Materials and Synthetic Fibers and Fiber-Like Materials Produced Thereof		

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**Request for Reconsideration****After Notification of Non-Compliant Appeal Brief**

Sir:

In response to the Notification of Non-Compliant Appeal Brief which was mailed on December 22, 2004, the following remarks are submitted for your consideration. This response is timely because January 22, 2005 fell on a Saturday, thus extending the response date until Monday, January 24, 2005.

On July 12, 2004, Appellants, in accordance with 37 C.F.R. § 1.192(a), timely filed an Appeal Brief.

A Notification of Non-Compliance with 37 C.F.R. § 1.192(c) was mailed on October 5, 2004.

On October 27, 2004, Appellants, in accordance with question A6 of the FAQ posted on the USPTO website regarding Rules of Practice before the BPAI (effective 13SEP2004) (a copy of which is attached hereto), timely filed an Amended Brief on Appeal complying with former 37 C.F.R. § 1.192.

A Notification of Non-Compliance with 37 C.F.R. § 41.37 was mailed on December 22, 2004.

Applicants respectfully request that the Amended Appeal Brief filed October 27, 2004 be reconsidered for compliance with former 37 C.F.R. § 1.192 because the same is based on an

appeal brief originally filed prior to September 13, 2004. According to the attached FAQ, question A6, an amended appeal brief, based on an appeal brief originally filed prior to September 13, 2004, would be acceptable if it complies with either former § 1.192 or § 41.37(c), regardless of when the Office mailed a Notice requiring correction of the noncompliant appeal brief. In this case, the amended appeal brief is based on an appeal brief originally filed on July 12, 2004, and should therefore be considered for compliance with former 37 C.F.R. § 1.192.

Please charge any prosecutorial fees which are due to Kimberly-Clark Worldwide, Inc. deposit account number 11-0875.

The undersigned may be reached at: 770-597-8626.

Respectfully submitted,

PALACIO ET AL.

By: 

Richard M. Shane

Registration No.: 50,921

#### Certificate of Transmission

I, Richard M. Shane, hereby certify that on January 24, 2005 this document is being facsimile transmitted to the Commissioner for Patents, United States Patent and Trademark Office, fax number 703-872-9306.

By: 

Richard M. Shane



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A. Effective Date (September 13, 2004); A11 added 19Oct2004; A12 added 4Jan2005.

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B. Time Periods for Filing Appeal Brief and Response to Examiner's Answer

C. Amendments and Affidavits or Other Evidence (§ 1.116 and § 41.33)

D. Notice of Appeal (§ 41.31); D3 updated 4Jan2005.

E. Appeal Brief (§ 41.37)

F. Examiner's Answer (Including New Ground of Rejection) (§ 41.39)

G. Reply Brief (§41.41)

H. Supplemental Examiner's Answer (§ 41.43)

I. Other Topics

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**A. Effective Date (September 13, 2004)****Questions related to Time Periods for Filing of Papers:****A1. If a notice of appeal is filed before September 13, 2004, the effective date of the BPAI final rule, when is the appeal brief due?**

If the notice of appeal is filed before September 13, 2004, the time period for filing an appeal brief will be the time period set forth in former § 1.192(a) which provides that the appellant must file an appeal brief: (1) within two months from the date of filing of the notice of appeal; or (2) within the time allowed for reply to the action from which the appeal was taken, if such time is later.

The time period set forth in former § 1.192(a) also applies if the notice of appeal is filed with a certificate of mailing or transmission in compliance with § 1.6 and the date on the certificate of mailing or transmission is before the effective date of September 13, 2004, but the notice of appeal is received by the Office on or after September 13, 2004. The two month time period will begin on the date of receipt of the notice of appeal.

**A2. If appellant reinstates the appeal after the prosecution is reopened by filing a second notice of appeal on or after the effective date, when is the second appeal brief due?**

Appellant must file the second appeal brief (in compliance with the format and content requirements of § 41.37(c)) within two months from the date of filing the second notice of appeal, even if the first notice of appeal and the first brief were filed before the effective date. The two month time period is extendable under the provisions of § 1.136 for patent applications and § 1.560(c) for *ex parte* reexamination proceedings. See § 41.37(e).

**A3. If a notice of appeal is filed on or after the effective date of September 13, 2004, would extensions of time under § 1.136(a) be required when a Request for Continued Examination (RCE) under § 1.114 or an amendment is filed after two months from the date of filing the notice of appeal, but within three months from the mailing of the action from which the appeal was taken?**

Yes, extensions of time under § 1.136(a) are required for filing an RCE or amendment after two months from the filing of the notice of appeal, even if the RCE or amendment is filed within the three months from the mailing of the action from which the appeal was taken.

**Questions related to Appeal Brief Contents or Requirements for Papers Filed after Appeal:**

**A4. If the notice of appeal is filed before the effective date of September 13, 2004 and the brief is filed by appellant on or after the effective date, would the appeal brief be required to comply with the content and format requirements of § 41.37(c)?**

Yes, any appeal brief filed on or after September 13, 2004 must be in compliance with the requirements set forth in § 41.37(c) and be accompanied by the appropriate fee under § 41.20(b)(2). If the brief does not comply with § 41.37(c), an amended brief will be required under § 41.37(d).

Exception: If the appeal brief is filed with a certificate of mailing or transmission under § 1.8 and the date on the certificate of mailing or transmission is before September 13, 2004, the appeal brief may comply with either former § 1.192 or new § 41.37, even if the appeal brief is received by the Office on or after September 13, 2004.

**A5. Would the Office accept an appeal brief filed before the effective date of September 13, 2004 that is in compliance with § 41.37(c)?**

Yes, a brief filed before September 13, 2004 that is compliant with the new § 41.37(c) will be acceptable.

**A6. If an appeal brief filed before the effective date of September 13, 2004 fails to comply with the content and format requirements of § 1.192 and the Office mails appellant a Notice that correction is required, would an amended appeal brief filed on or after the effective date be required to be in compliance with § 41.37(c)?**

No, an amended appeal brief, based on an appeal brief originally filed prior to September 13, 2004, would be acceptable if it complies with either former § 1.192 or § 41.37(c), regardless of when the Office mailed a Notice requiring correction of the noncompliant appeal brief.

**A7. If, after a final rejection or an appeal, applicant or appellant files an amendment, affidavit or other evidence on or after the effective date, will the revised or new rules in the BPAI Final Rule apply?**

Any affidavit or other evidence filed after a final rejection, or an appeal, on or after the effective date, will be subject to the revised or new rules (i.e., the revised § 1.116 or new § 41.33).

**Questions related to Examiner's Answers and Supplemental Examiner's Answers:**

**A8. If the appeal brief is filed before the effective date of September 13, 2004, but the examiner's answer is mailed on or after the effective date, can the examiner's answer include a new ground of rejection?**

Yes, an examiner's answer mailed on or after September 13, 2004 may include a new ground of rejection (with Technology Center Director or designee approval) in compliance with § 41.39. Any examiner's answer mailed before September 13, 2004, however, may not include a new ground of rejection. See former § 1.193.

**A9. Can the examiner provide a supplemental examiner's answer under § 41.43 on or after the effective date of September 13, 2004 in response to any new issue raised in a reply brief that was filed before the effective date?**

Yes, the examiner may provide a supplemental examiner's answer (with Technology Center Director or designee approval) if it is mailed on or after September 13, 2004 in response to any new issue raised in a reply brief, even if the reply brief was filed before September 13, 2004. Appellant may file another reply brief in compliance with § 41.41 to reply to the supplemental examiner's answer within two months from the date of mailing of the supplemental examiner's answer. Extensions of time under § 1.136(a) are not applicable to the two-month time period.

**A10. If the Board remanded an application before the effective date of September 13, 2004 for further consideration of a rejection, and the examiner provides a supplemental examiner's answer on or after the effective date (in response to the remand by the Board), can appellant request that prosecution be reopened under § 41.50(a)(2)(i)?**

No, appellant may not request that prosecution be reopened under § 41.50(a)(2)(i) in response to the supplemental examiner's answer since the Board remanded the application before the effective date. Appellant may request that prosecution be reopened in response to a supplemental examiner's answer written in response to the remand by the Board,